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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,642	07/03/2001	Selim Shlomo Rakib	TER-015.3D	2025
26717	7590	08/25/2004	EXAMINER	
FALK AND FISH 16590 OAK VIEW CIRCLE MORGAN HILL, CA 95037			WONG, ALBERT KANG	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,642

Applicant(s)

RAKIB, SELIM SHLOMO

Examiner

Albert K Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. This Office action is in response to the restriction requirement filed August 11, 2004.

Applicant has elected Group II, claims 3-12 without traverse. Claims 1-2 have been withdrawn from consideration. This application is a CIP of 09/602,512 which is a CIP of 09/483,681. The claimed subject matter is presumed to be first disclosed in the instant application. Thus, the priority date is July 3, 2001.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5-11, said "host computer" lacks an antecedent basis. Thus, it is not clear what qualifies as a host computer.

Regarding claim 7, the term "TIVO functions" is indefinite. The term has no accepted meaning in the art and the specification does not give this term a special definition.

Regarding claim 12, this claim is dependent on claim 33 which does not exist. It is presumed that this claim is dependent on claim 3. Applicant is advised to make appropriate corrections.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee 5,778,256.

Regarding claim 3, the claimed PDA is shown as Figure 2, item 10; the claimed wireless expansion transceiver card is shown as item 12; and the claimed memory for storing an operating system is inherent within a pda. Darbee does not explicitly show the connection of the expansion card with the pda. However, col. 1, lines 35-40 teaches the use of a PCMCIA port which is used to add functionality to a pda. A PCMCIA slot accepts cards which increase the functionality of the device. The cited passages includes communication devices. It would have been obvious to connect the transceiver to the slot which is connected to the bus of the pda.

Regarding claim 8, col. 1 teaches the reception of data packet radio and voice messages. MP3 files are merely special data packets that represent audio. It would have been obvious that the reception and decoding of audio packets/files is not limited to a particular format.

Regarding claims 9-10, see col. 1, line 39. The use of a particular protocol would have been obvious.

Regarding claim 11, address book and calendar functions are conventional within pdas.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee as applied to claim 3 above, and further in view of Adair 6,424,369.

Regarding claim 4, Darbee does not teach a frame buffer and programs to receive video and to decompress them. Adair teaches a pda with video capability. It would have been obvious to incorporate this function into any pda as suggested by Adair to enable the user to view videos on the pda.

7. Claims 5-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee as applied to claim 3 above, and further in view of Van Ryzin 6,255,961.

Regarding claim 5, Darbee does not teach the use of programs to enable the pda to act like a web browser. This feature is taught in Van Ryzin. It would have been obvious to use the pda remote control as a web browser as suggested by Van Ryzin.

Regarding claim 6, Darbee teaches the remote control of appliances. The appliances are not part of a network. Van Ryzin teaches the use of a remote control to control appliances in a network. It would have been obvious to use the remote control in Darbee to control appliances in a network as suggested by Van Ryzin.

Regarding claim 7, Darbee does not teach TIVO functions. These are conventional controls in a A/V appliance. Van Ryzin teaches the use of a remote control to control A/V devices. It would have been obvious to control any A/V appliance with a remote control. Where such a device is a video recorder, it would have been obvious to control standard functions (TIVO).

Regarding claim 12, it is conventional in networks for a node to determine the configuration of the network to allow it to communicate with other nodes. It would have been obvious to include such a feature so that the information would not have to be input and updated manually.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Numerous prior art is cited concerning the reception of videos and the display of videos on a pda. Examples have also been cited regarding the use of a pda in a web

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communication capacity. The applied art should not be considered to be the only relevant references. Applicant should consider all cited references prior to preparing a response.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 703-305-8884. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Albert K. Wong
August 23, 2004